

REMARKS

Please find the following remarks concerning the IDS, priority claim, declaration, 35 U.S.C. 112 rejections, and 35 U.S.C. 102(b) rejections.

IDS

Copies of the foreign patents and non patent literature are enclosed. Applicant respectfully requests the Examiner consider these references in the next Office action, and initial and sign the IDS filed October 11, 2005. Additionally, it is noted that Cite A8 was inadvertently omitted from the last line of the IDS. Applicant respectfully requests the Examiner to fully consider the International Search Report dated Jul 14, 2004 for PCT/NZ2004/000057 and initial the last line of the IDS.

Priority Claim

A proper priority claim was filed on the transmittal papers, see Transmittal paper of 10/11/2005 (attached for the convenience of the Examiner). This priority claim meets the requirements of 35 U.S.C. §119(a-d). Approval of the Applicant's priority claim is respectfully requested.

Oath/Declaration

The Examiner has objected to the Declaration filed on 12/08/06 because of a non-initialed or non-dated alteration was made to the Declaration. Mr. Pearson's actions of printing his full name immediately before signing and dating the oath were not violation of Rule 1.52(c)(1). Under this Rule, handwritten alterations to the Application may be made, provided that they are initialed and dated on the same sheet of paper. Applicant submits that the presence of Mr. Pearson's full signature operates as the equivalent of his initials and thus the declaration is compliant under Rule 1.52(c)(1).

35 U.S.C. §112

In view of the Applicant's present amendments to the claims, the Examiner's presently pending rejections under 35 U.S.C. §112 second paragraph are moot.

35 U.S.C. 102

Originally filed Claims 1-57 have been cancelled in favor of new claims 58-82. The structural components of the claimed DNA analysis system are not disclosed in Muir et al 6,251,600, Woodley (Analytical Chemistry (1996) 4081-4086), or Belgrader (Laboratory Research and Automation (1997) 9: 3-7) as evidenced by the ABI Prism 310 Genetic Analyzer User's Manual (1998) (collectively the "Prior Art").

Applicant thanks the Examiner for the Office action of 2/29/08, and kindly requests the Examiner to reconsider the Prior Art in view of the new claims. Claims 57-82 are patentable over the Prior Art for a number of different reasons and indication of allowable subject matter by the Examiner is respectfully requested.

Conclusion

In view of the foregoing, the Applicants respectfully request that the Examiner consider the claims as amended for examination on the merits. A timely allowance of the pending claims is requested. If there are any fees (such as necessary extension of time or extra claims fees) due in connection with the filing of this Response and Amendment which are not covered by the concurrently submitted transmittal document, please charge any necessary fees or credit any overpayments to Deposit Account No. 50-1349. The Examiner is invited to contact Applicants' undersigned attorneys and agents by telephone

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to discuss any matters if the Examiner feels such discussions may expedite the progress of the present application toward allowance.

Respectfully submitted,

Dated: December 31, 2008

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| FORM PTO-1390 (Modified) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE (REV. 5-93) | | ATTORNEY'S DOCKET NUMBER 87036-0005 |
| TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 | | IS APPLICATION NO. (REVISED 37 C.F.R. 1.52) Unassigned 10/552159 |
| INTERNATIONAL APPLICATION NO. PCT/NZ2004/000057 | INTERNATIONAL FILING DATE March 23, 2004 | PRIORITY DATE CLAIMED April 8, 2003 |
| TITLE OF INVENTION DNA ANALYSIS SYSTEM | | |
| APPLICANT(S) FOR DO/EO/US Daksh SADARANGANI, Bruce MACDONALD, Paul CALVERLEY, Allen RODRIGO, David SAUL, Scott BAKER, and Mike PEARSON | | |
| Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information: | | |
| <ol style="list-style-type: none">1. <input checked="" type="checkbox"/> This is a FIRST submission of items concerning a filing under 35 U.S.C. 371.2. <input type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371.3. <input checked="" type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.4. <input checked="" type="checkbox"/> The US has been elected (Article 31).5. <input checked="" type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2))<ul style="list-style-type: none"><input checked="" type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau)<input type="checkbox"/> has been communicated by the International Bureau.<input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US)6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)):<ul style="list-style-type: none"><input type="checkbox"/> is attached hereto.<input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).7. <input checked="" type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))<ul style="list-style-type: none"><input type="checkbox"/> are attached hereto (required only if not transmitted by the International Bureau).<input type="checkbox"/> have been communicated by the International Bureau.<input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.<input checked="" type="checkbox"/> have not been made and will not be made.8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4))10. <input type="checkbox"/> An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)). | | |
| Items 11 to 20 below concern other document(s) or information included: | | |
| <ol style="list-style-type: none">11. <input checked="" type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98, PTO Form 1449 and copy of International Search Report.12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.13. <input checked="" type="checkbox"/> A preliminary amendment.14. <input type="checkbox"/> A substitute specification.15. <input type="checkbox"/> A power of attorney and/or change of address letter.16. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.82517. <input type="checkbox"/> A second copy of the published international application under 35 U.S.C. 154(d)(4).18. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).19. <input type="checkbox"/> Other items or information: | | |

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(Modified)